



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,893	11/13/2001	Roy Kayser	7750-113	6255

7590

04/10/2002

Shawn D. Jacka
Bereskin & Parr
40 King Street West
Box 401
Toronto, ON M5H 3Y2
CANADA

EXAMINER

LEE, WILSON

ART UNIT

PAPER NUMBER

2821

DATE MAILED: 04/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/986,893

Applicant(s)

Roy Kayser

Examiner

Wilson Lee

Art Unit

2821



-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Nov 13, 2001

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-23 is/are pending in the application

4a) Of the above, claim(s) none is/are withdrawn from consideration

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-14 and 18-23 is/are rejected.

7) ☒ Claim(s) 15-17 is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirements

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) ☐ Other: _____

Art Unit: 2821

DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 1 and 14 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6,333,602. This is a double patenting rejection.

Regarding Claim 1, Claim 1 of the '602 patent discloses a light source comprising a light generator, a sensor for sensing operational parameters of the light generator, a light source data storage device integrated with the light generator and operatively coupled to the sensor, for storing operational parameters data correlated to the operational parameters of the light generator, and a light source connector adapted to operatively couple the light source to a light emitting device. All these limitations meet claim 1.

Regarding Claim 14, in addition, Claim 1 of the '602 patent discloses a device housing, a socket adapted to releasably engage the light source connector, wherein the socket is mounted to the device housing; a controller for retrieving the operational parameters data from the light source data storage device, wherein the controller is operatively coupled to the socket, and a

Art Unit: 2821

power source mounted to the device housing and operatively coupled to the controller and to the socket. All these limitations meet claim 14.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 11, 12 and 13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4 and 5 respectively of U.S. Patent No. 6,333,602. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claim 1 of the '602 patent clearly discloses that the socket adapted to releasably engage the light source connector. It indicates that the connector and the socket are interlocked. The '602 also discloses that the controller retrieves data from the storage device and is operatively coupled to the socket(connector). Accordingly, it shows that the connector or the socket is coupling the controller.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2821

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 18, 19, 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Tamagaki(4,760,609).

Regarding Claim 18, Tamagaki discloses a light source comprising a light generator(6, 7 or 8), and a CPU(17) as a non-volatile light source data storage device integrated with the light generator, for storing operational parameters data correlated to the operational parameters of the light generator(See Figure 7 and Col. 5, lines 41-63).

Regarding Claim 19, Tamagaki discloses in Figure 7 that the light source data storage device(CPU) stores operational parameters data associated only with the light generator(6, 7 or 8) (See Col. 5, lines 41-63).

Regarding Claim 21, Tamagaki discloses in Figure 7 that the light source data storage device(CPU) is mounted to the light generator(6, 7 or 8).

Regarding Claims 22 and 23, Tamagaki discloses in Figure 7 that the light source data storage device(17) is inseparably integrated with and permanently affixed to the light generator(6, 7 or 8).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

Art Unit: 2821

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-10, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tamagaki(4,760,609).

Regarding Claim 1, Tamagaki discloses a light source comprising a light generator(6, 7 or 8) comprising a light device(e.g. filaments of the tube 6), a CCD sensor(5) as a sensor for sensing operational parameters(e.g. intensity, temperature) of the light generator, a CPU(17) as a light source data storage device integrated with the light generator and operatively coupled to the sensor(5), for storing operational parameters data correlated to the operational parameters of the light generator(See Figure 7).

As discussed above, Tamagaki essentially discloses the claimed invention but fails to disclose a light source connector. However, it would have been obvious to one of ordinary skill in the art to provide connectors in the designated wire connection in Tamagaki to expand the capability/portability without cutting things(e.g. wire, cable) apart in order to ease the burden of shipping.

Regarding Claim 2, Tamagaki, as discussed above in the preceding rejection on claim 1, essentially discloses the claimed invention but fails to disclose a housing means. However, it would have been obvious to one of ordinary skill in the art to provide a housing means to enclose Tamagaki's lamp apparatus in order to protect the fragile electrical components from moisture

Art Unit: 2821

and other damages. Further, providing a housing or casing to enclose one's invention without producing unexpected and improved results is not considered as a novelty.

Regarding Claim 3, Tamagaki discloses that the operational parameters is correlated to the light generator temperature(See Figure 1 and Col. 1, lines 31-41).

Regarding Claim 4, Tamagaki discloses the parameters data correlated to whether or not a preselected maximum operating temperature has been exceeded during operation(See Abstract).

Regarding Claim 5, Tamagaki discloses that the light generator means is a fluorescent lamp(See Col. 3, line 40).

Regarding Claim 6, as described in the preceding rejection on claims 1 and 2, Tamagaki meets the limitation of claim 6.

Regarding Claim 7, Tamagaki discloses a sensor(5) for sensing operational parameters(e.g. intensity, temperature) of the light generator(6, 7 or 8), wherein the sensor is operatively coupled to the controller(17) (See Figure 7).

Regarding Claim 8, Tamagaki discloses that the operational parameters is correlated to the light generator temperature(See Figure 1 and Col. 1, lines 31-41).

Regarding Claim 9, Tamagaki discloses the parameters data correlated to whether or not a preselected maximum operating temperature has been exceeded during operation(See Abstract).

Regarding Claim 10, Tamagaki discloses that the light generator means is a fluorescent lamp(See Col. 3, line 40).

Art Unit: 2821

Regarding Claim 20, as discussed above, Tamagaki essentially discloses the claimed invention but fails to disclose a light source connector. However, it would have been obvious to one of ordinary skill in the art to provide connectors in the designated wire connection in Tamagaki to expand the capability/portability without cutting things(e.g. wire, cable) apart in order to ease the burden of shipping.

Allowable Subject Matter

9. Claims 15-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kuwabara(5,150,154) discloses an apparatus for forming images discharge lamp and current, tone and temperature control means. Northrup(4,533,854) discloses a mechanism and method for controlling the temperature and output of a fluorescent lamp.

Correspondence

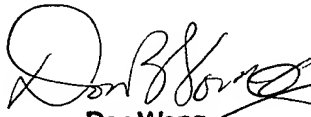
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Wilson Lee whose telephone number is (703) 306-3426.

12. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist whose telephone number is (703) 308-0956.

Art Unit: 2821

13. Papers related to Technology Center 2800 applications may be submitted to Technology Center 2800 by facsimile transmission. Any transmission not to be considered an official response must be clearly marked "DRAFT". The Technology Center Fax Center number is (703) 308-7722 or (703) 308-7724.

WL
04/02/2002


Don Wong
Supervisory Patent Examiner
Technology Center 2800